

mn

## Office Action Summary

Application No.

10/538,162

Applicant(s)

GRANT ET AL.

Examiner

Eron J. Sorrell

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on preliminary amendment filed 6/8/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/4/006; 1/6/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 8-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Claims 8-14 are directed toward a computer-readable medium. At paragraph 52 of the instant specification, it appears that the computer-readable storage medium is defined as not being limited to statutory embodiments, for example the transmission media. The Examiner interprets these claims to include non-statutory embodiments such as electro-magnetic signals and the like (See MPEP 2106). The Examiner suggests amending the preamble of claims 8-14 to include language of "a computer readable storage medium comprising instructions that when executed by a processor..." and amending the specification to distinguish the computer-readable storage media from computer-readable transmission media.

Art Unit: 2182

4. Claims 15 and 16 are directed toward "a data stream embodied in a carrier signal." Such an embodiment does not fall within one of the statutory categories set forth in 35 USC 101. A data stream embodied in a signal carrier is clearly not a method nor a machine, and not manufacture or composition of matter, thus claims 15 and 16 are non-statutory.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1,2,4,8,9,11,15, and 17-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Brisebois et al. (U.S. Patent No. 6,359,550 hereinafter "Brisebois").

7. Referring to method claim 1, computer-readable medium claim 8, data stream claim 15, and apparatus claim 17, Brisebois teaches an apparatus, method, and computer-readable medium, the apparatus (figure 5) comprising:

a processor (item 30, figure 5);

Art Unit: 2182

an actuator in communication with the processor (item 40, figure 5); and

a memory in communication with the processor (item 32, figure 5), the memory storing program code executable by the processor, including:

program code for receiving an input signal (see input signal 34, and paragraph bridging columns 5 and 6);

program code for extracting a haptic code from the input signal, the haptic code being associated with a haptic logo (see paragraph bridging columns 5 and 6); and

program code for providing a control signal to the actuator, the control signal being based at least in part on the haptic code and configured to cause the actuator to output a haptic effect associated with the haptic logo (see paragraph bridging columns 5 and 6, note a code is extracted from the input signal, this code is then correlated with to a haptic pattern representing a status which is output in a designated pattern).

8. Referring to method claim 2, computer-readable medium claim 9, and apparatus claim 20, Brisebois teaches the haptic logo is associated with a status event (see lines

Art Unit: 2182

21-58 of column 6, note each status event has a separate logo or pattern).

9. Referring to method claim 4, computer-readable medium claim 11, Brisebois teaches the effect is output to a handheld communication device (see lines 9-13 of column 4).

10. Referring to claim 18, Brisebois teaches the actuator is coupled to a handheld communication device (see lines 9-13 of column 4).

11. Referring to claim 19, Brisebois teaches (the handheld communication device includes at least one of a cellular phone, a satellite phone, a cordless phone, a personal digital assistant, a pager, a two-way radio, a portable computer, a game console controller, a personal gaming device, and an MP3 player (see lines 13-23 of column 4, wherein Brisebois teaches the device can be integrated into a personal communication device).

Art Unit: 2182

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 5-7,12-14,16, and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (U.S. Patent No. 6,727,916) in view of Wies et al. (WO 02/03172 A2 hereinafter "Wies").

14. Referring to method claim 5, computer-readable medium claim 12, data stream 16, and apparatus claim 24, Ballard teaches a method and apparatus (figure 2), the apparatus comprising:

a processor (item 32, figure 2);  
a display module in communication with the processor (item 34 figure 2); and  
a memory in communication with the processor (see item 28, figure 2), the memory storing program code executable by the processor, including:

Art Unit: 2182

program code for receiving an input signal associated with a chat message and for causing a graphical representation associated with the chat message to be displayed on the display module (see line 57 of column 7 to line 23 of column 8);

Ballard fails to teach an actuator in communication with the processor; program code for outputting a control signal to the actuator, the control signal configured to cause the actuator to output a haptic effect associated with the chat message.

Wies teaches, a chat system, wherein the system comprises an actuator (item 30, figure 1) in communication with a processor (item 26, figure 1); and a memory storing program code for outputting a control signal to the actuator, the control signal configured to cause the actuator to output a haptic effect associated with a chat message (see lines 13-20 of column 8).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the method and apparatus of Ballard with the above teachings of Wies. One of ordinary skill in the art would have been motivated to make such modification in order to provide additional information to a recipient of the

Art Unit: 2182

message that may not be apparent from a text or voice message as suggested by Wies (see lines 31-33 of page 1).

15. Referring to claim 6,7,13, and 14, Wies teaches extracting a haptic code from the input signal, the control signal being based at least in part on the haptic code (see lines 25-35 of page 11) and correlating the haptic effect is with an expression of the graphical representation (see line 26 of page 12 to line 2 of page 13).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the method and apparatus of Ballard with the above teachings of Wies for the same reasons as mentioned above.

16. Referring to claim 25, Wies teaches the actuator coupled to a handheld device (see item 14, figure 1).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the method and apparatus of Ballard with the above teachings of Wies for the same reasons as mentioned above.



Art Unit: 2182

17. Referring to claim 26, Ballard teaches the handheld device comprises at least a PDA (see figure 1, and lines 21-42 of column 7).

18. Referring to claims 27 and 28, Ballard teaches a the handheld device comprises an LCD display screen (see lines 40-49 of column 1).

19. Claims 3,10, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brisebois in view of Austin-Lane et al. (U.S. Pub. No. 2004/0059790 hereinafter "Austin-Lane").

20. Referring to method claim 3, computer-readable medium claim 10, and apparatus claim 21, Brisebois teaches the method, computer-readable medium, and apparatus of claims 2,9, and 20 as shown above, however the combination fails to teach the status event includes at least one of an advertisement event, a business-transaction event, a one-to-one marketing event, a stock-trading event, a weather-forecast event, an entertainment event, a sports event, and an emergency event.

Austin-Lane teaches, in an analogous system, the status event comprising at least an advertisement event (see paragraph 33).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Brisebois with the above teachings of Austin-Lane. One of ordinary skill in the art would have been motivated to make such modification in order to provide the user with a notification of important time-sensitive information as suggested by Austin-Lane (see paragraph 3).

21. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brisebois in view of Wies.

22. Referring to claims 22 and 23, Brisebois teaches the apparatus of claim 17 as shown above, however Brisebois fails to teach the memory further stores a haptic lookup table associating a plurality of haptic codes each with a control signal the memory further stores program code to download the haptic lookup table from a remote source.

Wies teaches, in an analogous system, the above limitations (see paragraph bridging pages 14 and 15, note the library disclosed by Wies, which can be downloaded from

Art Unit: 2182

a network server, is being construed as the applicant's claimed table).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Brisebois with the above teachings of Wies in order to give the user a greater range of events by allowing for customization as suggested by Brisebois (see paragraph bridging pages 14 and 15).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J. Sorrell whose telephone number is 571 272-4160. The examiner can normally be reached on Monday-Friday 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2182

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EJS

July 21, 2007

 7/21/07